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RECORD OF ORAL HEARING

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

*Ex parte* SYLVIA MONSHEIMER, RAINER GOERING, and HANS RIES

Appeal 2009-006938  
Application 10/670,528  
Technology Center 3700

Oral Hearing Held: January 13, 2010

Before JENNIFER D. BAHR, JOHN C. KERINS, and  
STEVEN D.A. MCCARTHY, *Administrative Patent Judges.*

ON BEHALF OF THE APPELLANT:

JAMES J. KELLY, Ph.D.  
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The above-entitled matter came on for hearing on Wednesday, January 13, 2009, commencing at 10:10a.m., at the U.S. Patent and Trademark Office, 600 Dulany Street, Alexandria, Virginia, before Paula Lowery, Notary Public.

THE CLERK: Calendar Number 31, Appeal Number 2009-006938, Mr. Kelly.

JUDGE BAHR: Good morning.

MR. KELLY: Good morning, Your Honors.

JUDGE BAHR: You can start whenever you're ready.

MR. KELLY: We're claiming a composite part produced by connecting a plastic pipe to another plastic part.

The most important feature that brings us here today is that our other plastic part has at least one nipple providing for the connection of a pipe to where the nipple is provided on the outside of the profile. It's used to fuse or connect the plastic pipe and this other plastic part.

The Examiner cited two references against us. The first reference is this Savitski patent. The important feature of this first reference is that the joint - actually, the connection that's produced when the two parts are fused together, you have simultaneous lap and butt joints.

My understanding of a butt joint is simply you have two ends of two pipes, or two connectors. You bring the ends in proximity, and then you treat them in such a way as to melt them or soften them with a solvent, and you fuse them together to create a butt joint.

So the reference is very clear that when these two pieces are connected, you get both a lap joint and a butt joint. That's in the Abstract, the first line, and it's also in the "Background of the Invention" section, Column 1; and in the

1 "Field of the Invention," right about line 19. There's several other places  
2 where the butt joint is described.  
3 Now, the Examiner recognizes that this primary reference Savitski does not  
4 describe the use of a nipple. However, the Examiner has cited the secondary  
5 reference Fisher-Keller, which you can see in Figure 3, contains a nipple. I  
6 believe that's item 14 -- reference 14.

7 The Examiner has taken the position that it's obvious to one skilled in the art  
8 to take the nipple that's described in Fisher-Keller and use it in the method  
9 and product that's obtained in the Savitski patent.

10 It's our position that while the primary reference doesn't explicitly exclude  
11 the possibility of using a nipple, the fact that you're forming a butt joint  
12 implicitly teaches away from the use of a nipple.

13 Because as you can see in the figure on the front page of the Fisher-Keller  
14 reference, which I believe is a reproduction of Figure 3, when you use a  
15 nipple and connect that way, you simply don't form a butt joint. It's just not  
16 the product.

17 JUDGE MCCARTHY: Counsel, does Savitski give any reason why it is  
18 desirable to have both a butt and lap joint?

19 MR. KELLY: In Column 2 Savitski states, this is in the back of the  
20 invention section after describing -- I'm sorry.

21 I don't know if there's a discussion of that. I'm not finding it looking at the  
22 reference now.

23 JUDGE MCCARTHY: If I understand correctly, Savitski doesn't criticize  
24 or disparage the use of a nipple along with a laser welding, according to  
25 Savitski's method?

26 MR. KELLY: I believe there's no explicit teaching against using a nipple.

1 JUDGE MCCARTHY: If I'm not mistaken, the Examiner says that it would  
2 be obvious to combine a nipple, as taught by Fisher-Keller, with Savitski's  
3 welding method in order to preposition the two pipes or the pipe and other  
4 plastic part with respect to each other before welding.

5 Is the Examiner's reasoning faulty in some particular way?

6 MR. KELLY: Is that in the final rejection? I'm just trying to find --

7 JUDGE MCCARTHY: In the Answer at the bottom of page 4.

8 MR. KELLY: I'm not aware that that statement is incorrect. I'd just point  
9 out that if you did use a nipple, as the Examiner suggests, you would not end  
10 up with the butt joint that's explicitly taught and required by the Savitski  
11 reference.

12 JUDGE MCCARTHY: Please continue with your argument.

13 MR. KELLY: So in summary, there's no explicit teaching away from using  
14 a nipple in Savitski, but the description and requirement for a butt joint  
15 provides an implicit teaching away.

16 JUDGE MCCARTHY: So I take it it's your position that one of ordinary  
17 skill in the art at the time your client's invention was made would not have  
18 been able to, through the exercise of common sense, step beyond the  
19 particular teaching of a butt joint and use -- combine a nipple as taught by  
20 Fisher-Keller with the method of Savitski?

21 MR. KELLY: I wouldn't characterize it as use of common sense. I would  
22 say that there's no motivation to do so.

23 JUDGE MCCARTHY: So your position is that obviousness can't be found  
24 unless there is some particularized motivation to make the combination?

25 MR. KELLY: In this particular case where the reference specifically

1 requires the formation of one specific type of connection, there would be no  
2 motivation to modify the teaching of that reference so that it wasn't formed.  
3 JUDGE MCCARTHY: But wouldn't the Examiner's reasoning at the  
4 bottom of page 4 of the Answer, or what I just referred to a few minutes ago,  
5 provide one of ordinary skill in the art reason to make the combination?  
6 Namely to enable preassembly of the pipe and other plastic part?

7 MR. KELLY: In this case I don't have an explicit argument against that  
8 statement. It's just that if you use a nipple in this case, you don't form a butt  
9 joint.

10 JUDGE BAHR: Do you have anything else you want to add?

11 MR. KELLY: That's it.

12 JUDGE BAHR: We'll take this case under advisement. Thank you.

13 Whereupon, the proceedings at 10:20 a.m. were concluded.  
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